

REMARKS

Reconsideration of the pending application is respectfully requested on the basis of the following particulars.

1. Rejection of claims 1-4 under 35 U.S.C. § 112 first paragraph

This rejection is respectfully traversed on the basis that the rejection has not met the burden required to establish a *prima facie* case of non-enablement.

The proper test to determine enablement is whether any person skilled in the art can make and use the invention without undue experimentation (MPEP §2164.01; *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988)). The initial burden is on the Patent Office to establish a reasonable basis to question the enablement provided by the specification (MPEP 2164.04; *In re Wright*, 999 F.2d 1557, 1562 (Fed. Cir. 1993)).

There are at least eight factors that must be analyzed to make a finding of non-enablement (MPEP §2164.01(a); *In re Wands*, 858 F.2d at 737 (Fed. Cir. 1988)). While it is not necessary to discuss every factor, the language of the rejection should focus on the factors, reasons, and evidence that lead the Office “to conclude that the specification fails to teach how to make and use the claimed invention without undue experimentation” (MPEP §2164.04, underlining in original). The analysis can be done “by making specific findings of fact, supported by evidence, and then drawing conclusions based on these findings of fact” (MPEP §2164.04). In a situation where the Office alleges there is missing information in the specification, the Office “should specifically identify what information is missing and why one skilled in the art could not supply the information without undue experimentation” (MPEP §2164.04).

In the pending case, the rejection states that pending claim 1 must have at least one clamp arm, as disclosed in the specification. The inference from the rejection must be that one having ordinary skill in the art of clamping devices would not be able to make or use a clamp as claimed without a clamping arm as described in the specification.

However, there is simply no analysis or findings of fact relating to any of the eight factors, for example the level of ordinary skill in the art, which are used to make a finding of undue experimentation. The rejection merely points out what is allegedly missing from the claims, skips the evidentiary findings required to make a *prima facie* case of undue experimentation, and jumps to the conclusion that the claims as written are not enabled.

This analysis is improper and conclusory and fails to meet the burden required by the Office to establish a *prima facie* case of non-enablement.

Further, it is respectfully submitted that one having ordinary skill in the art of clamping devices could make or use the embodiment of pending claim 1. The specification never states that the at least one clamp arm is a critical feature of the clamping apparatus.

In fact, the specification makes reference on page 1, lines 9-23, to Japanese Patent Public Disclosure JP10-277858, which corresponds to US patent no. 6,073,325. This publication shows an example of a clamping device that functions without the use of a clamping arm.

The specification further discloses on page 8, lines 7-9, that the features of the disclosure may be used in combination with other types of clamping devices, such as a rotating clamp or a work support.

Additionally, the transitional phrase in claim 1 "wherein" is open ended. Thus, the embodiment of pending claim 1 must have the recited elements, but also may have additional elements that are not recited. Therefore, one having ordinary skill in the art of clamping devices would recognize that they may provide additional features to the embodiment of pending claim 1 without effecting the functionality of the embodiment of claim 1.

Thus, it is clear from the evidence that one having ordinary skill in the art of clamping devices is enabled to make or use the clamping apparatus as recited in pending claim 1. Accordingly, withdrawal of this rejection is respectfully requested.

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Examiner: WILSON, Lee D.
Art Unit: 3723

2. Allowable subject matter

The applicant gratefully acknowledges the indication of allowable subject matter.

3. Conclusion

In view of the foregoing remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is respectfully requested that every pending claim in the present application be allowed and the application be passed to issue.

If any issues remain that may be resolved by a telephone or facsimile communication with the applicant's attorney, the examiner is invited to contact the undersigned at the numbers shown below.

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Respectfully submitted,



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